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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/023,700 | 12/21/2001 | Richard Hatch | 1076.41036X00 | 6915 |
| 43829 | 7590 | 06/28/2006 | EXAMINER | |
| ROBERT M BAUER, ESQ. LACKENBACH SIEGEL, LLP 1 CHASE ROAD SCARSDALE, NY 10583 | | | DEAN, RAYMOND S | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2618 | |

DATE MAILED: 06/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) |
|------------------------------|------------------------|---------------------|
| | 10/023,700 | HATCH ET AL. |
| Examiner | Art Unit | |
| Raymond S. Dean | 2618 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 20 April 2006.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 3, 11, 13 - 30 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 3, 11, 13 - 30 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 15 March 2002 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 0905,0406.
4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
5) Notice of Informal Patent Application (PTO-152)
6) Other: ____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed April 20, 2006 have been fully considered but they are not persuasive.

Examiner respectfully disagrees with Applicants' assertion on Page 7 2nd Paragraph of the Remarks "Although, the patent discusses displaying words ...". The words that are frequently found in common or widespread usage are the words that are frequently used or selected by users when communicating thus the words displayed in the O'Dell reference are the words selected by the user.

Regarding Claim 15, Examiner respectfully disagrees with Applicants' assertion "The discussion in the O'Dell patent addressed above teaches ..." for the same reasons as set forth above.

Regarding Claims 11 and 21 – 25, Examiner respectfully disagrees with Applicants' assertion "it does not teach the features recited in the rejected ..." for the same reasons as set forth above.

Regarding Claims 14, 17, and 22, Schroeder further teaches the feature of the frequency of use by the user is determined dynamically (See Schroeder Col. 5 lines 46 – 51).

Regarding Claims 15, 18, and 23, Schroeder further teaches the feature of adding new words to the dictionary (See Schroeder Col. 7 lines 26 – 29).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 3, 11, 13 – 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schroeder et al. (5,797,098) an in further view of O'Dell (US 6,801,659).

Regarding Claim 3, Schroeder teaches an electronic device comprising a display (Figure 1A, display (11)); and a memory storing a dictionary of words (Column 6 lines 30 – 31), wherein the device is adapted to, in response to a text entry, select a plurality of words in said dictionary predicted to correspond to said entry (Figure 4, Column 6 lines 17 – 41), and display the plurality of selected words on said display (Figure 4).

Schroeder does not teach displaying the plurality of selected words on said display in an order based on the frequency of use of the plurality of the selected words by the user.

O'Dell teaches displaying the plurality of selected words on said display in an order based on the frequency of use of the plurality of the selected words (Column 4 lines 25 – 31, Column 7 lines 29 – 39, See Also Response To Arguments above).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Schroeder with the word use frequency

method of O'Dell for the purpose of providing faster text entry to a user as taught by O'Dell.

Regarding Claim 11, Schroeder teaches a method of predicting text on an electronic device the method including the steps of: recognizing an entry of text by a user of the device (Figure 4, Column 6 lines 17 – 41); selecting a plurality of words stored in a dictionary responsive to the text entry (Figure 4, Column 6 lines 17 – 41); and displaying at least one of the plurality of selected words on a display of the device (Figure 4).

Schroeder does not teach the display being based on the frequency of use of the plurality of selected words by the user.

O'Dell teaches the display being based on the frequency of use of the plurality of selected words by the user (Column 7 lines 29 – 39, See Also Response To Arguments above).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the word use frequency method taught above by O'Dell in the wireless phone of Schroeder for the purpose of providing faster text entry to a user as taught by O'Dell.

Regarding Claim 13, Schroeder teaches a software program stored on a tangible medium readable by an electronic device (Figure 1B, Col. 3 lines 46 – 50), which when run on the electronic device is operable to cause said device to perform a method of predicting text, the method comprising: selecting a plurality of words from a dictionary of words stored in a memory and predicted in response to entry of text by the user (Figure

4, Column 6 lines 17 – 41); displaying the plurality of selected words on a display of the device (Figure 4).

Schroeder does not teach the display being based on the frequency of use of the plurality of selected words by the user.

O'Dell teaches the display being based on the frequency of use of the plurality of selected words by the user (Column 7 lines 29 – 39, See Also Response To Arguments above).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Schroeder with the word use frequency method of O'Dell for the purpose of providing faster text entry to a user as taught by O'Dell.

Regarding Claim 14, Schroeder in view of O'Dell teaches all of the claimed limitations recited in Claim 13. Schroeder further teaches a computer readable medium that comprises a flash memory (Figure 1B, Col. 3 lines 46 – 50), and the frequency of use of the plurality of selected words by the user is determined dynamically at the time of said entry of text by the user (Col. 5 lines 46 – 51).

Regarding Claim 15, Schroeder in view of O'Dell teaches all of the claimed limitations recited in Claim 13. Schroeder further teaches wherein new words may be added to the dictionary (Col. 7 lines 26 – 29), updating a plurality of counter bits for each word in the dictionary used by the user according to the frequency of use of each (Column 7 lines 45 – 47, the memory stores the dictionary and the count, which comprise bits). O'Dell further teaches modifying the order of the plurality of selected

words displayed in respect of the text entry based on the values of a plurality of counts (Column 7 lines 29 – 39, when word list search key is pressed the order of the list will change based on the frequency of use, which is based on the counts).

Regarding Claims 16, 26, Schroeder in view of O'Dell teaches all of the claimed limitations recited in Claims 3, 13. Schroeder further teaches wherein only one of said selected plurality of words is displayed (Column 6 lines 46 – 61, at least one candidate word is displayed, which means there can be just one candidate word displayed). O'Dell further teaches a word being the word that is most frequently used by the user (Column 7 lines 29 – 39).

Regarding Claims 17, 27, Schroeder in view of O'Dell teaches all of the claimed limitations recited in Claims 16, 26. O'Dell further teaches wherein a plurality of selected words are sequentially displayed one at a time (Column 7 lines 39 – 41, when the 'select word' key is pressed one word will be displayed at a time), the order of the displayed words being based on the frequency of use of the plurality of selected words by the user (Column 7 lines 29 – 39). Schroeder further teaches said frequency of use being determined dynamically at the time of the text entry (Col. 5 lines 46 – 51).

Regarding Claims 18, 28, Schroeder in view of O'Dell teaches all of the claimed limitations recited in Claims 17, 27. Schroeder further teaches wherein new words may be added to the plurality of words in said dictionary (Col. 7 lines 26 – 29). O'Dell further teaches wherein each sequential display of a word is made in response to the user pressing a key (Column 7 lines 39 – 41).

Regarding Claims 19, 29, Schroeder in view of O'Dell teaches all of the claimed limitations recited in Claims 3, 13. Schroeder further teaches wherein the electronic device comprises a mobile telecommunications device (Figure 1A).

Regarding Claims 20, 30, Schroeder in view of O'Dell teaches all of the claimed limitations recited in Claims 19, 29. O'Dell further teaches wherein the text entry comprises part of the text of a message to be sent by said mobile telecommunications device (Column 4 lines 25 – 29, transmission by SMS comprises transmitting part of the text of a message).

Regarding Claim 21, Schroeder in view of O'Dell teaches all of the claimed limitations recited in Claim 11. Schroeder further teaches wherein only one of said selected plurality of words is displayed (Column 6 lines 46 – 61, at least one candidate word is displayed, which means there can be just one candidate word displayed). O'Dell further teaches a word being the word that is most frequently used by the user (Column 7 lines 29 – 39).

Regarding Claim 22, Schroeder in view of O'Dell teaches all of the claimed limitations recited in Claim 21. O'Dell further teaches wherein a plurality of selected words are sequentially displayed one at a time (Column 7 lines 39 – 41, when the 'select word' key is pressed one word will be displayed at a time), the order of the displayed words being based on the frequency of use of the plurality of selected words by the user (Column 7 lines 29 – 39). Schroeder further teaches said frequency of use being determined dynamically at the time of the text entry (Col. 5 lines 46 – 51).

Regarding Claim 23, Schroeder in view of O'Dell teaches all of the claimed limitations recited in Claim 22. Schroeder further teaches wherein new words may be added to the plurality of words stored in the dictionary (Col. 7 lines 26 – 29). O'Dell further teaches wherein each sequential display of a word is made in response to the user pressing a key (Column 7 lines 39 – 41).

Regarding Claim 24, Schroeder in view of O'Dell teaches all of the claimed limitations recited in Claim 11. Schroeder further teaches wherein the electronic device comprises a mobile telecommunications device (Figure 1A).

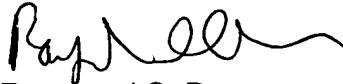
Regarding Claim 25, Schroeder in view of O'Dell teaches all of the claimed limitations recited in Claim 24. O'Dell further teaches wherein the text entry comprises part of the text of a message to be sent by said mobile telecommunications device (Column 4 lines 25 – 29, transmission by SMS comprises transmitting part of the text of a message).

Conclusion

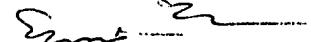
4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond S. Dean whose telephone number is 571-272-7877. The examiner can normally be reached on Monday-Friday 6:00-2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward F. Urban can be reached on 571-272-7899. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Raymond S. Dean
June 23, 2006



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